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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/731,068

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Thomas J. Maginot

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EXAMINER

PREBILIC, PAUL B

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/731,068

Applicant(s)

MAGINOT, THOMAS J.

Examiner

Paul B. Prebilic

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 6-84 and 202-259 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 5, 131, 133, 138, 139, 260, 261 and 263 is/are allowed.
- 6) ☐ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) 193 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are 1,4-86,90-92,97-99,101-103,105,110,111,114,119,122,123,127-129,131,133,138,139,141,146,153-155,157,162,169-171,173,175,182-184,186,191,194,195,198-200,202-261,263 and 264.

Continuation of Disposition of Claims: Claims rejected are 1,4,85,86,90-92,97-99,101-103,105,110,111,114,119,122,123,127-129,141,146,153-155,157,162,169-171,173,175,182-184,186,191,194,195,198-200 and 264.

### ***Election/Restrictions***

Claims 6-84 and 202-259 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim.

Applicant's election of Group I in the reply filed on February 3, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP 818.03(a)).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of copending Application No. 10/726,803 in view of Redtenbacher et al (US 4,817,847). Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending claims are narrower in scope than the present

claims but are read on by the present claims except for the "endoscopic" instrument use as claimed herein. However, Redtenbacher teaches that endoscopic use during similar anastomosis procedures was known; see column 3, lines 16-25 and the paragraph bridging columns 6 and 7. Therefore, it is the Examiner's position that it would have been obvious to use an endoscope in the procedure of the copending claims for the same reasons that Redtenbacher uses the same and in order to perform the procedure with greater accuracy and precision.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/824,043 in view of Redtenbacher et al (US 4,817,847). Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending claims are narrower in scope than the present claims but are read on by the present claims except for the "endoscopic" instrument use. However, Redtenbacher teaches that endoscopic use during similar anastomosis procedures was known; see column 3, lines 16-25 and the paragraph bridging columns 6 and 7. Therefore, it is the Examiner's position that it would have been obvious to use an endoscope in the procedure of the copending claims for the same reasons that Redtenbacher uses the same and in order to perform the procedure with greater accuracy and precision.

***Claim Rejections Based Upon Prior Art***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 85, 86, 90-92, 97-99, 101-103, 105, 110-111, 114, 119, 122, 123, 127-129, 141, 146, 153-155, 157, 162, 169, 170, 171, 173, 175, 182-184, 186, 191, 194, 195, 198, 199, 200, and 264 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaster (US 5,234,447) in view of Palmaz (US 4,733,665). Kaster teaches the claimed invention where the locating step as claimed is the step of inserting the blood vessel into the mandrel of Kaster (see column 2, lines 63-68), the blood conveying vessel as claimed is the blood vessel (51) of Kaster, the advancing step as claimed is shown in Figures 14-19 of Kaster, and the vessel as claimed is the second vessel of Kaster; see column 6, line 5 to column 7, line 20. The removing step as claimed is disclosed on column 7, lines 8-14.

However, Kaster fails to disclose the structure of having the attachment end or the entire conduit within the delivery device as claimed. However, Palmaz teaches that it was known to deliver similar grafts to blood vessels via catheters; see column 1, lines 20-30. Therefore, it is the Examiner's position that it would have been obvious to use a catheter over the mandrel and staple of Kaster for the same reasons that Palmaz does the same and in order to protect the staple, mandrel, sleeve, and the bypass blood vessel prior to and during the procedure.

Regarding Claims 101-103, 105, 110-112, and 123, Kaster does not disclose using the method thereof specifically on an aorta. However, since Kaster is a generic method of attaching blood vessels in an anastomosis, it is the Examiner's position that it would have been considered *prima facie* obvious to utilize the method of Kaster to anastomize an aorta based upon the need of a patient to have a bypass of a portion of the aorta. Since the Kaster device can be utilized on any blood vessel, it is reasonable that it could be utilized on an aorta as well if the same condition from bypass are present as those disclosed by Kaster; see column 1.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaster (US 5,234,447) in view of Redtenbacher et al (US 4,817,847) or Avant (US 5,047,039). Kaster meets the claim language as explained above but fails to disclose the use of an endoscope or laparoscope during the process as claimed. However, Redtenbacher teaches that endoscopic use during anastomosis procedures was known; see column 3, lines 16-25 and the paragraph bridging columns 6 and 7. Likewise, Avant teaches laparoscopic anastomosis was known; see the title and abstract. Therefore, it is the

Examiner's position that it would have been obvious to use a endoscope or laparoscope in the Kaster procedure so that it could have been performed with greater accuracy and precision due to the greater visibility of the site.

***Allowable Subject Matter***

Claim 193 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 5, 131, 133, 138, 139, 260, 261, and 263 are allowed over the prior art of record.

***Response to Arguments***

Applicant's arguments filed February 2, 2006 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the Kaster and Palmaz references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, two motivations are clearly provided in the rejection as "for the same reasons that Palmaz does the same and in order to protect the staple, mandrel, sleeve, and the



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bypass blood vessel prior to and during the procedure.” For this reason, the argument that there is no motivation to combine these references is not persuasive.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Prebilic  
Primary Examiner  
Art Unit 3738